

REMARKS

Claims 1-163 are present in the application and are pending on the merits. In the Office Action, claims 90-121, 138-142, and 161-163 were allowed. Claims 21-23, 39-41, 78, 79, 83-85, and 131-133 were objected to as being dependent on a rejected base claim and indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant wishes to thank the Examiner for the indication of allowable subject matter.

Claims 1-19, 24-32, 36-37, 42-77, 80-82, 89, 122-130, and 134-137 were rejected under 35 U.S.C. § 102(e) as being anticipated by Giacchetti (U.S. 2003/0065589). Claims 1-2, 11, 12, 20, 38, 42, 69-72, 82, 86-88, 122, 123, 130, and 134-136 were rejected under 35 U.S.C. § 102(b) as being anticipated by Maddison et al. (U.S. Patent No. 3,571,947). Claims 33-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maddison et al. Of these rejected claims, claims 1, 43, 69, and 122 are independent.

Applicant submits that the rejection under 35 U.S.C. § 102(e) based on Giacchetti should be withdrawn, because Giacchetti does not qualify as prior art under 35 U.S.C. § 102(e). The language of 35 U.S.C. § 102(e) provides that "[a] person shall be entitled to a patent unless . . . (e) the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." M.P.E.P. § 2136.03(I) further provides that "applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date." The instant application claims priority under

35 U.S.C. § 119 to French Application No. 00 16771, filed on December 21, 2000. This priority date antedates the earliest effective filing date, i.e., October 1, 2001, listed on the face of Giacchetti. Therefore, Giacchetti does not qualify as prior art under 35 U.S.C. § 102(e), and the rejection of claims 1-19, 24-32, 36-37, 42-77, 80-82, 89, 122-130, and 134-137 under 35 U.S.C. § 102(e) should be withdrawn.

In order to perfect the foreign priority claimed under 35 U.S.C. § 119 and pursuant with M.P.E.P. § 706.02(b), attached hereto is an English translation of the foreign priority document, French Application No. 00 16771, as well as a statement signed by the translator declaring that the translation is a true translation.

In view of the above, Applicant respectfully requests the withdrawal of the rejection under 35 U.S.C. § 102(e) based on Giacchetti.

Applicant respectfully traverses the rejection of claims 1-2, 11, 12, 20, 38, 42, 69-72, 82, 86-88, 122, 123, 130, and 134-136 under 35 U.S.C. § 102(b) as being anticipated by Maddison et al. because Maddison et al. does not disclose a method including all the claimed features including, among other things, "generating a sequence of images simulating *varying degrees* of at least one typological characteristic of an external body portion," as recited in claims 1, 69, and 122. (Emphasis added).

Maddison et al. discloses a means for identifying skin blemishes by a lay person in which a transparent film 10 carries a plurality of blemishes 12 thereon. (Col. 1, lines 3-7, and col. 2, lines 16-17). The blemishes 12 are formed to simulate various types of blemishes, such as, for example, "rings" 16 simulating Poison Oak, or blemishes simulating Poison Ivy, Measles, Chicken Pox, and the like. (Col. 2, lines 17-21 and col. 3, lines 50-55). Maddison et al. further discloses placing the transparent film 10

against the body adjacent to a blemish on the body so that the lay person can compare the blemishes on the body and on the film 10 in order to determine what kind of blemishes are on the body. (Col. 4, lines 64-69). Maddison et al. nowhere discloses or otherwise suggests, however, presenting blemishes 12 on the film 10 that are of “varying degrees,” as recited in claims 1, 69, and 122. Rather, Maddison et al. discloses presenting a plurality of varying *types* (i.e., not varying *degrees*) of blemishes (e.g., Poison Oak, Poison Ivy, measles, etc.) on differing films, and does not disclose any variation in degree of the blemishes within the plurality of blemishes 12 of a particular type. Indeed, it appears Maddison et al. discloses the same degree of blemish of each particular type being placed on the film 10. For at least this reason, the rejection of claims 1, 69, and 122 under 35 U.S.C. § 102(b) should be withdrawn.

In view of the above, Applicant submits that claims 1, 43, 69, and 122 are allowable over the cited references. Claims 2-42 and 143-160; 44-68; 70-89; and 123-137 depend from claims 1, 43, 69, and 122, respectively, and are thus allowable for at least the same reasons the claims from which they depend are allowable.

Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §§ 102 and 103, the reconsideration of this application, and the allowance of claims 1-163.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant’s undersigned representative at 571-203-2717.

Applicant respectfully submits that the Office Action contains numerous assertions concerning the related art and the claims. Regardless of whether those

assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: August 12, 2005

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Attachments:

English language translation of French Patent Application 00 16771
Declaration of translator